



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Franz H. Herbert, et al.

Serial No: 10/647,641

Filed: 8/25/2003

For: SYSTEM FOR SELECTING AND
CREATING COMPOSITION FORMULATIONS

Examiner: Anthony J. Blackman

Group Art Unit: 2676

Docket No. 032264.00027

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action dated January 25, 2005, restriction to one of two inventions of the following inventions was required under 35 U.S.C. § 121.

Invention I was designated as claims 1-25. The Office Action states that these claims are drawn to comparing selection criteria with color characteristic of computation component database, classified in class 345, subclass 593.

Invention II was designated as claims 26-50. The Office Action said that these claims are drawn to color corrected display and storage of special effects, classified in class 382, subclass 167.

As the basis for the restriction, the Office Action stated that Inventions I and II are distinct because Inventions I and II are related as a combination and sub-combination. The Office Action states that these inventions are distinct contending that it can be shown that: (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability; and, (2) that the sub-combination has utility by itself or in other combinations.

M.P.E.P. § 806.05(C). The Office Action states that the combination does not require the particulars of the sub-combination as claimed are separately usable. Specifically, the Office Action states that because comparing selection criteria with color characteristic of computation component database and the color corrected display with storage of special effects does not require the particulars of the sub-combinations.

Respectfully, Applicant traverses the election requirement and respectfully requests that the election requirement be withdrawn for the following reasons.

Claims 1-25 are directed towards the same invention as claims 26-50. Specifically, the following table compares several elements of the independent claims of the groups defined by the Office Action showing that Inventions I and II are the same invention, should be classed together, and do not require separate searches.

Claim 1 – Invention I	Claim 26 – Invention II
A system for selecting composition components for a composition formulation for a product to be manufactured according to a set of selection criteria	A method for selecting a composition component for inclusion in a composition formulation for a product to be manufactured according to a set of selection criteria
a composition component database in communication with said computer readable medium representing composition components used in composition formulations for manufacturing products having color characteristics	providing a set of composition components representing composition components used in composition formulations for manufacturing products having color characteristics
receiving selection criteria representing desirable color characteristics of a product to be manufactured	receiving said selection criteria representing desirable color characteristics of a product to be manufactured
selecting at least one composition component from said composition component database that has color characteristics within a predetermined range of said selection criteria	selecting at least one composition component from said set of composition components having color characteristics within a predetermined range of said selection criteria
displaying said at least one selected composition component to a user via said color display	displaying said at least one selected composition for viewing on a color corrected display

Claim 14 – Invention I	Claim 40 – Invention II
A system for selecting composition formulations for a product to be manufactured according to a set of selection criteria	A method for selecting a composition formulation for a product to be manufactured according to a set of selection criteria
a composition formulation database in communication with said computer readable medium representing formulations having at least one composition component for manufactured products having desirable color characteristics	providing a set of composition formulations representing composition formulations used for manufacturing products having color characteristics
receiving selection criteria representing desirable properties of a composition formulation for a product to be manufactured	receiving said selection criteria representing desirable color characteristics of a product to be manufactured
selecting at least one composition formulation from said composition formulation database having color characteristics within a predetermined range of said selection criteria	selecting at least one formulation from said set of composition formulations having color characteristics within a predetermined range of said selection criteria
display said at least one selected composition formulation to a user via said color display	displaying said at least one selected composition formulation for viewing on a color corrected display

As illustrated above, independent claims 1 and 14 of Invention I are directed to the same invention as corresponding independent claims 26 and 40 of Invention II.

Since the elements of independent claims of Invention I set forth the elements of independent claims of Invention II, the sub-combination cannot be shown to have utility by itself or with other relations. Therefore, Applicant respectfully submits that the restriction requirement should be withdrawn as not meeting the requirement of M.P.E.P. § 806.05(C)(B).

Further, the Office Action states that Invention II, claims 26-50, are drawn to color corrected display and storage of special effects. Claim 2 of Invention I includes the element “instructions for calibrating said color display to enable said display to provide color correct images”, thereby providing a color corrected display. Claim 25 of Invention I includes the element “at least one special effect stored within said computer readable medium”, thereby providing for storage of special effects.

As shown, Invention I contains the elements cited by the Office Action as being in Invention II. Since Invention I contains the elements of Invention II, Applicant respectfully requests the restriction requirement be withdrawn as not complying with M.P.E.P. § 806.05(C)(A).

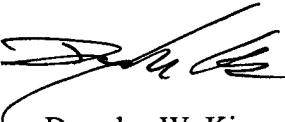
Since Invention I is directed towards the system for carrying out the method provided in Invention II and Invention II is directed towards the method used by the system of Invention I, Applicant submits that Invention I and Invention II are directed towards the same invention.

Further, the search for claims 1 through 50 can be performed within the same field. Since the elements of Invention I and Invention II are contained within the elements of these claims, there is no additional burden to search the invention.

Applicant provisionally elects claims 1 through 25 and respectfully traverses the election requirement.

For the above stated reasons, it is suggested that the restriction and election requirements are improper pursuant to M.P.E.P. § 806.05(C)(A)-(B) and Applicant respectfully requests it to be withdrawn so that an action on the merits can be given to all claims presented. If the election is not withdrawn, Applicant's undersigned attorney would be happy to discuss this matter so as to allow an action on the merits of all claims presented.

Respectfully submitted,



Douglas W. Kim
Registration No. 44,828
McNair Law Firm, P.A.
P.O. Box 10827
Greenville, SC 29603-0827
Telephone: (864) 232-4261
Attorneys for the Applicant